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Dated: April 29, 2005

Signature: Heather Edwards

(Heather Edwards)

JW
AF
Docket No.: 65856-0032
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Jack D. Patterson

Application No.: 09/881,536

Confirmation No.: 8152

Filed: June 14, 2001

Art Unit: 2831

For: CONNECTIONLESS DATA LINK
ASSEMBLY

Examiner: J. J. Lee

REPLY BRIEF

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Commissioner for Patents

United States Patent and Trademark Office

Washington D.C. 20231

Dear Sir:

This is a Reply Brief submitted pursuant to 37 C.F.R. § 41.41 in response to the Examiner's Answer mailed March 1, 2005 ("Examiner's Answer"). Appellant's Appeal Brief ("Appeal Brief") was filed on February 10, 2004.

Claims 1-16 are pending in the application, and claims 1-12 are the subject of this Appeal. No claims have been allowed. The present application was filed on February 14, 2000 with originally-filed claims 1-16. In response to the Office Action mailed May 7, 2002, Appellant on June 3, 2002 filed a Response to Restriction Requirement provisionally electing, with traverse, claims 1-12. In response to the Final Office Action mailed November 15, 2002 ("Final Office Action"), and the Advisory Action mailed February 4, 2003 ("Advisory Action"), Appellant filed a Notice of Appeal on February 18, 2003.

Claims 1-3, 6-9, and 12 were rejected in the Final Office Action under 35 U.S.C. § 103(a) over the "conventional art as described in the [Appellant's] specification and [Appellant's] prior art Figure 2." The Final Office Action further rejected Claims 4, 5, 10, and 11 under 35 U.S.C. § 103(a) over the conventional art as described in the Appellant's

specification and Appellant's prior art Figure 2 in view of U.S. Patent No. 6,257,923 to Stone et al. ("Stone") and U.S. Patent No. 4,929,477 to Will ("Will").

The Examiner's Answer now provides new grounds of rejection for claims 2 and 8, namely as obvious over the prior art as disclosed by Appellant in view of Radox "Plug and Play" Cable ("Radox").¹ Further, the Examiner's Answer rejected claims 3 and 9 as obvious over the prior art as disclosed by Appellant in view of U.S. 5,882,215 ("Burns"), another new rejection. Appellant elects to present arguments traversing these new rejections and to continue this appeal pursuant to 37 C.F.R. § 41.39(b)(2).

Accordingly, pursuant to Section 41.39(b)(2), Appellant herein below addresses the new grounds of rejection, as required by 37 C.F.R. 41.37(c)(1)(vii). Also pursuant to Section 41.39(b)(2), Sections I, II, III, IV, V, and VII, and also the Appendix, of the Appeal Brief are hereby fully incorporated herein by reference in their entireties in order to meet the requirements of 37 C.F.R. 41.37(c). Additionally, a new statement of the grounds of rejection presented for review is provided herein below in the section entitled "Issues Presented" in order to meet the requirements of 37 C.F.R. § 41.37(c)(1)(vi).

ISSUES PRESENTED

- A. Whether Claims 1, 6-7 and 12 are unobvious over the prior art as disclosed by Appellant.
- B. Whether Claims 4, 5, 10, and 11 are unobvious over the prior art as disclosed by Appellant in view of Stone and Will.
- C. Whether Claims 2 and 8 are unobvious over the prior art as disclosed by Appellant in view of Radox "Plug and Play" Cable ("Radox").
- C. Whether Claims 3 and 9 are unobvious over the prior art as disclosed by Appellant in view of Burns.

¹ The Examiner asserted that "Radox is presented merely in support of the Examiner's statement of Official Notice [and i]n no way should the presentation of Radox be construed as a new or different grounds of rejection." (Examiner's Answer, page 6.) To the contrary, inasmuch as Radox was nowhere mentioned in the record prior to the Examiner's Answer, and requires new arguments, Appellant respectfully submits that Radox does constitute a new ground of rejection of claims 2 and 8. However, the issue of whether Radox presents a new ground of rejection is moot in view of Appellant's decision to continue this appeal pursuant to 37 C.F.R. § 41.39(b)(2).

ARGUMENT

A. Independent Claims 1 And 7 Recite A Novel Structure.

Independent claims 1 and 7 were rejected under 35 U.S.C. 103(a) over the “conventional art as described in the [Appellant’s] specification and [Appellant’s] prior art Figure 2.” Claims 1 and 7 recite, among other limitations, “an engine shunt portion spliced into said trunk portion.” The Examiner’s Answer (page 3) clarifies that a “112 new matter rejection [of claims 1 and 7] was not made in the advisory nor in any office action,” but fails to further rebut, much less surmount, Appellant’s arguments in the Appeal Brief concerning the rejection of claims 1 and 7 under Section 103.

The Examiner argued that claims 1 and 7 are product-by-process claims reciting “splicing [which] is a method limitation,” and that claims 1 and 7 accordingly fail to recite a novel structure. (Examiner’s Answer, page 3.) However, as explained in the Appeal Brief (pages 7-8), claims 1 and 7 recite not a product made by a process, e.g., splicing, but rather an apparatus in which “an engine shunt portion spliced into said trunk portion” is a limitation on the structure of the apparatus. The Examiner has failed to rebut the explanation in the Appeal Brief regarding the novel structure of the claimed invention; in particular, the Examiner has failed to explain how the structure known in the prior art is the same as the presently claimed structure having “an engine shunt portion spliced into said trunk portion.” Appellant, on the other hand, has repeatedly explained that the claimed connectionless data link assembly, i.e., “an engine shunt portion spliced into said trunk portion,” was not known in the prior art; the prior art teaches only data link assemblies disadvantageously having plugged connections. (*E.g.*, Appeal Brief, pages 3-5.)

Moreover, the Examiner has improperly ignored the undisputed commercial advantages of the invention recited in claims 1 and 7. (*See* Appeal Brief, page 8.) Indeed, the Examiner’s Answer does not address the issue of objective indicia supporting patentability (sometimes called “secondary considerations”) at all. Instead, the Examiner merely stated the proposition, inapplicable to the instant case, that “forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art.” (Examiner’s Answer, page 4.) However, the case cited by the Examiner, Howard v. Detroit Stove Works, 150 U.S. 164 (1893), does not support this broad proposition. Rather, in Howard, where the

prior art taught putting together two pieces of a stove with lugs and rivets, the U.S. Supreme Court held that it was not novel to assemble the stove pieces with bolts and rivets. *Id.* at 169. Thus, the patent discussed in Howard did not present a novel claim because it simply recited putting together known parts in a known way. Claims 1 and 7, in contrast, recite a connectionless data link assembly having fewer parts than previously known, including a structural feature unknown in the prior art, i.e., “an engine shunt portion spliced into said trunk portion.”

Accordingly, independent claims 1 and 7 are in condition for allowance. Further, claims 2-6 all depend directly or indirectly from claim 1. Claims 8-12 all depend directly or indirectly from claim 7. Accordingly, all claims are in condition for allowance for at least the reasons stated above.

B. The Examiner Has Failed to Cite Prior Art Teaching The Limitations Of Claims 2 and 8, Much Less Motivation For Those Limitations.

Claims 2 and 8 were rejected under 35 U.S.C. 103(a) over the “conventional art as described in the [Appellant’s] specification and [Appellant’s] prior art Figure 2.” Claims 2 and 8 recite that “said trunk portion” of the pre-assembled data link assembly, recited in claims 1 and 7 respectively, “comprises a multiplex cable.” In response to Appellant’s argument that the use of a multiplex cable in the trunk portion of the data link assembly as recited in claims 2 and 8 is not “capable of instant and unquestionable demonstration as being well-known,” the Examiner has provided a new ground of rejection, citing an alleged prior art reference entitled Radox “Plug and Play” Cable (“Radox”). However, as the Examiner stated, Radox teaches at most use of a multiplex “cable *with* a drivetrain of a vehicle.” (Examiner’s Answer, page 5; emphasis added.) Claim 2 explicitly recites a “vehicle drivetrain,” and Radox nowhere even suggests that a vehicle drivetrain must or even should contain a multiplex cable. Indeed, the mere fact that a multiplex cable *can* be used with a drivetrain does not teach or suggest that a multiplex cable *should* be so used. Similarly, claim 8 recites a “data link assembly,” and Radox nowhere teaches or suggests that a data link assembly must or even should contain a multiplex cable. The Examiner’s burden of a *prima facie* case of obviousness would be met only if the Examiner produced prior art showing multiplex cables must be used in vehicle drivetrains and data link assemblies, or at least that such structures should include multiplex cables. The Examiner has made no such showing.

For at least the forgoing reasons, claims 2 and 8 are separately patentable, and are in condition for allowance.

C. Claims 3 and 9 Are Allowable Because The Examiner Has Wrongly Asserted That Housing First And Second Termination Resistors In A Barrel Mold Would Have Been Obvious.

Claims 3 and 9 each recite that “said first and second termination resistors are housed in a barrel mold.” In the Final Office Action (page 3), claims 3 and 9 were rejected under 35 U.S.C. 103(a) over the “conventional art as described in the [Appellant’s] specification and [Appellant’s] prior art Figure 2,” because housing the first and second termination resistors in a barrel mold allegedly would have been “an obvious matter of design choice.” However, the Examiner’s Answer (page 6) newly rejected claims 3 and 9 as obvious over “[t]he admitted prior art figure 2” in view of U.S. 5,882,215 (“Burns”). In response, Appellant provides the following reasons why the newly stated rejection of claims 3 and 9 should not stand.

Burns discloses in part a “coaxial cable connector apparatus.” (Abstract.) However, Burns contains no teaching or suggestion of anything having to do with the “vehicle drivetrain” or “data link assembly” required by Appellant’s claims. Indeed, Burns teaches and suggests no more than that a “barrel connector” was considered to be a “standard cable connector” prior to Appellant’s claimed invention. (Col. 8, lines 8-9.) Appellant respectfully submits that the mere fact that barrel connectors may have been known prior to Appellant’s claimed invention is insufficient to provide a motivation to use such connectors in the context of the claimed invention. Burns contains no reasons for the use of a barrel connector in the context of his or any other invention, and thus can contain absolutely no teaching or suggestion that would have motivated one of ordinary skill in the art to have modified the known prior art such that “said first and second termination resistors are housed in a barrel mold.”

For at least the forgoing reasons, claims 3 and 9 are separately patentable, and are in condition for allowance.

D. The Examiner Failed To State A Prima Facie Case Of Obviousness For Combining The References Cited Against Claims 4-5 and 10-11.

Claims 4 and 10 recite that the data link assembly further comprises “a double wall shrink tube for covering said engine shunt portion and said transmission shunt portion.” Claims 4-5 and 10-11 were rejected under 35 U.S.C. 103(a) over “[Appellant’s] specification and [Appellant’s] prior art Figure 2 in view of” Stone and Will. In the Appeal Brief (pages 10-11), Appellant noted that the Examiner had failed to state a *prima facie* case of obviousness because the cited combination of prior art failed to teach all of the limitations of Appellant’s claims. The Examiner responded solely by quoting her statement from the Final Office Action that

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the double wall shrink tube as taught by Stone et al. and Will on the assembly as disclosed in Applicant's specification and Applicant's prior art figure 2 **in order to interconnect different parts.**" The motivation statement has been bolded.

(Examiner's Answer at 6-7; emphasis in original.) As explained in the Appeal Brief, and as amplified below, the foregoing statement of motivation is insufficient to meet the Examiner's burden of a *prima facie* case of obviousness in at least two ways.

First, the Examiner still has not provided a specific motivation to combine the cited references to meet Appellant's claim limitations. That is, the Examiner has not explained why one of ordinary skill in the art would have been motivated to select a double wall shrink tube for "interconnect[ing] different parts." Second, even if the Examiner had stated a specific motivation sufficient to support a *prima facie* case for the combination of the cited references, the Examiner still has failed to find support in any of the prior art of record for the proposed combination. Indeed, the Examiner has provided no citation to any of the prior art of record teaching or suggesting the desirability of "a double wall shrink tube for covering said engine shunt portion and said transmission shunt portion." Accordingly, the Examiner has failed to meet her burden of stating a *prima facie* case of obviousness at least because (1) the Examiner has failed to state a sufficient motivation to combine the cited references to meet Appellant's claim limitations and (2) the Examiner has not shown that the prior art of record in fact contains any motivation to combine the cited references.

For at least the foregoing reasons, claims 4-5 and 10-11 are separately patentable, and are in condition for allowance.

CONCLUSION

Appellants respectfully submit that all of the appealed claims in this application (claims 1-12) are patentable for at least the reasons stated above and request that the Board of Patent Appeals and Interferences overrule the Examiner and direct allowance of the rejected claims. Only one novel and non-obvious element is required for patentability. The rejection of Appellants' claims was not proper because the Examiner failed to: (i) disclose all of the claim elements in prior art; and (ii) provide evidence supporting the assertion that a suggestion or motivation existed in the art to combine the references as asserted by the Examiner.

Appellant believes that no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 18-0013, under Order No. 65856-0032, from which the undersigned is authorized to draw.

Dated: April 29, 2005

Respectfully submitted,

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